OIPE
NOV 18 2005

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission	14

Application Number	09/576,462
Filing Date	05/23/2000
First Named Inventor	Burke Thompson
Art Unit	3621
Examiner Name	James Reagan
Attorney Docket Number	22851-P001US

ENCLOSURES *(Check all that apply)*

- [ ] Fee Transmittal Form
  - [ ] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Reply to Missing Parts/ Incomplete Application
  - [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53

- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
  - [ ] Landscape Table on CD

- [ ] After Allowance Communication to TC
- [ ] Appeal Communication to Board of Appeals and Interferences
- [x] Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- [ ] Proprietary Information
- [ ] Status Letter
- [x] Other Enclosure(s) (please Identify below):
  Return Postcard

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Winstead Sechrest & Minick P.C.
Signature	
Printed name	Kelly K. Kordzik
Date	11/15/2005

Reg. No.	36,571

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature	
Typed or printed name	Toni Stanley

Date	11/15/2005

AF
ipw

- 1 -

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application: Thompson et al.

Serial No.:   09/576,462

Filed: May 23, 2000

Art Unit: 3621

Examiner: James Reagan

For: SYSTEM AND METHOD FOR PROCESSING IMPORT/EXPORT
                     TRANSACTIONS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

In response to the Examiner's Answer, dated September 20, 2005, Appellants respond as follows:

I.   REJECTIONS UNDER 35 U.S.C. § 112

Claim 47 stands rejected with an insufficient antecedent basis problem. In response, Appellants have filed an amendment currently herewith, whereby claim 47 has been amended to properly depend upon claim 46. MPEP §1207.

II.   REJECTIONS UNDER 35 U.S.C. § 101

Claims 24-26 and 46-50 stand rejected under 35 U.S.C. §101. In response, Appellants have filed an amendment to these claims to remove the term "adaptable" to overcome these rejections. MPEP §1207.

III.   MEANS PLUS FUNCTION CLAIMS

The Examiner has requested that Appellants identify every means plus function and step plus function in the claims. In response, Appellants hereby provide descriptions of such means plus function and step plus function limitations as described in the Specification along with page and line numbers, and reference characters in the Drawings as applicable:

Claim 10

The "means for inputting invoice data associated with an import/export transaction at a first terminal coupled to the network, wherein the invoice data includes a product identifier identifying a product to be transported in the import/export transaction" is shown in Figures 1-3. Detail of an invoice 102 with invoice data associated with an import/export transaction including a product identifier identifying a product to be transported in the import/export transaction is shown in detail in Figure 3. Invoice 102 is also shown in Figure 1. Page 12, lines 9-18 of the Specification describes the particulars of the invoice 102. Page 13, lines 8-14 of the Specification describes a process whereby such an invoice is sent in electronic format or manually inputted at a website 104. Page 16, lines 1-5 describes how the invention shown in Figure 1 can be implemented over a network, which comprises components similar to the data processing system shown in Figure 2.

The limitation "means for transferring the invoice data from the first terminal to a server hosting a database of product identifiers and tariff classification information particular to each of the product identifiers" is also shown in Figures 1 and 2. Page 16, lines 1-5 again describes how the exemplary system in Figure 2 can be used for the various components of the network shown in Figure 1. Page 6, lines 11-17 describes how the product classification database of the present invention can be Internet-based and accessable from any PC within a network. Such a database is shown as item 110 in Figures 1 and 3, showing product identifiers and tariff

classification information particular to each of the product identifiers. Page 13, lines 8-14 also describes some transferring means.

The "means for matching the product identifiers identifying the product to the product identifiers in the database" is shown in Figures 1-3. The matching step 109 is shown in Figures 1 and 3, and may be implemented as software as described with respect to Figure 2 on pages 17 and 18 of the Specification. Page 13, line 15 through page 14, line 1 describes the matching step 109, and is further described on page 14, lines 4-7.

The "means for outputting a data record in response to the matching of the product identifier identifying the product to the product identifiers in the database, wherein the data record includes tariff classification information associated with the product identifiers identifying the product" is described in the Specification on page 14, line 16 through page 15, line 7 where a customs entry report 116 is compiled and then a master report is created in step 117 shown in Figures 1 and 3, both showing the master report 117. Various ways for outputting such a report is described in this part of the Specification also.

Claim 11

The "outputting means includes a means for e-mailing the data record to a second terminal coupled to the network" is shown in Figure 1 and described on page 15, lines 1-7.

Claim 12

The "outputting means includes a means for downloading the data record to a second terminal coupled to the network" is also shown in Figure 1 and described on page 15, lines 1-7. This is shown in Figure 1 as the Internet connection between the 117 and 118 steps.

Claim 13

The "means for printing the data record" is described on page 15, line 4.

Claim 14

The "data record is downloaded in response to access of the data record and the server by the second terminal using a web browser, wherein the network is the Internet" is also described on page 15, lines 1-7.

Claims 15 and 16

The "means for electronically transmitting the invoice data from the first terminal to the server" and "means for inputting the invoice data into a website associated with the database" are described at page 12, lines 9-18, page 13, lines 8-14, and page 16, lines 1-5, where in Figure 1 these means are also shown with respect to steps 101-105 and 107-108.

Claim 17

The "means for updating the database from a third terminal coupled to the network" is described on page 14, lines 2-3, as step 111 in Figure 1.

Claim 18

The "means for recording results of the matching step into a transaction database hosted by the server" is described on page 14, lines 14-15. Such data records are also shown in Figure 1 as items 114 and 115.

IV.   REJECTIONS UNDER 35 U.S.C. § 103

Appellants hereby incorporate their arguments from the Appeal Brief.

On page 5 of the Supplemental Examiner's Answer, the Examiner has now identified specific portions of *Pool* for addressing each of the limitations in claim 1. Appellants traverse that these recitations in *Pool* adequately disclose the recited limitations.

Column 3, lines 60-77 merely sets the stage for the description for the invention in *Pool*, which uses computer databases and systems to implement the

purchase of goods and services over a network such as the Internet for both national and international transactions.

Column 14, lines 1-19 describes a transaction program that interacts with databases and systems, whereby the transaction system includes seven identified items. One of these is product codes from harmonized tariff tables, including tax and import information, including administrative requirements and data for satisfying such requirements as well as foreign duty information, including methods of calculating all duties, luxury taxes, etc. Note, Appellants respectfully assert that this particular item does not disclose the particular limitations in the claims whereby product identifiers particular to specific products are matched with tariff classification information particular to each of the product identifiers.

Column 4, lines 20-31 merely discloses that the databases interact as shown in Figure 1.

Column 4, lines 32-43 merely discloses that a language can be determined for communicating with a customer.

Column 4, lines 44-54 merely discloses that a process begins by allowing a customer to access online catalogs.

What is important about the foregoing is that for a § 103 rejection, each and every one of the limitations must be found within the cited prior art. The Examiner has now been requested by the Board to particularly point out where the limitations in claim 1 are found in *Pool*. The citations by the Examiner still do not specifically address and disclose the claim limitations. They merely begin the process of describing an online system for buying goods and services over a network with databases accessible for determining various parameters associated with a transaction. Appellants are not claiming such a general system, but instead are claiming a particular process for matching tariff classification information with particular products imported or exported having product identifiers. The Examiner cannot show that the present invention is obvious by merely describing a general system for purchasing goods and services over the Internet and combining it with a database system. As argued by Appellants in the Appeal Brief, and further argued below, the

Examiner has been unable to find, in the prior art, the particular invention recited in this Application, and has had to rely upon generalizations and broad assumptions in order to attempt to arrive at a *prima facie* case of obviousness. As Appellants have argued in the Appeal Brief and further below, the Examiner's arguments fail to prove a *prima facie* case of obviousness, as is required under the law.

Appellants will now respond to the Response to Argument on pages 24-30 of the Supplemental Examiner's Answer. The Examiner has asserted that the Abstract alone reads upon "invoice data, first terminal, import/export transaction, and product ID." Appellants did not just claim these items, but instead claimed their interaction as recited. The Examiner then apparently asserts that adding *Kroenke* with *Pool* discloses such interactions either explicitly, implicitly or inherently.

First, Appellants have shown in their Appeal Brief how the combination of these two references fails to "explicitly" disclose these limitations. With respect to the implicit and inherent teachings of the prior art, the Examiner is respectfully requested to refer to MPEP § 2112. The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. Inherency may not be established by probabilities or possibilities. *Id.* The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art. *Id.* The limitations not explicitly disclosed within the prior art references are not implicit or inherent in the teachings of these prior art references, and the Examiner has not provided any objective evidence meeting the standards of MPEP §2112. It does not <u>necessarily</u> flow out of the combination of *Pool* and *Kroenke* to match product identifiers identifying the product to the product identifiers in the database, wherein the database includes product identifiers and tariff classification information particular to each of the product identifiers so that a data record is output that includes tariff classification information associated with the product identifier identifying the product imported or exported.

The Examiner has asserted that "transferring data between a computer and a database is an integral and inherent part of a database system." This may be true, but Appellants are not merely attempting to claim the transference of data between a computer and a database. The Examiner must address the "transferring step" as it is fully recited within the claim and not parse it to address merely certain portions of it.

The Examiner has asserted that "the system of *Pool* could not function even in a rudimentary manner if required database identifiers (primary keys) were not present and utilized." Appellants respond that this is an unsupported statement, and does not adequately traverse Appellants' assertion that *Pool* does not teach or suggest a database of product identifiers and tariff classification information particular to each of the product identifiers. In a manner, the Examiner's assertion is non-responsive. The Examiner then goes on to assert "that the system of *Pool must* contain various identifiers to maintain a structured record of parts, product and services for importing and exporting." Again, this is an unsupported assertion by the Examiner. If *Pool* must disclose what the Examiner asserts, then the Examiner needs to find such teachings within the *Pool* patent. The Examiner has not done so. Furthermore, such teachings are not inherent, and the Examiner must show how such characteristics necessarily flow from the teachings of the *Pool* patent. *Id.* Further, the claims do not merely recite product identifiers.

The Examiner has asserted:

> With regard to Appellant's assertions that *Pool* does not
> disclose databases or database functionality, *Pool* does
> disclose the plurality of computer databases and
> systems in column 3, lines 63 to 64.

First, the Examiner has misquoted Appellants. Second, the claims recite more than mere databases or database functionality in general.

The Examiner goes on to further assert:

> The manipulation of data as well as the nature of the
> data and the use of the data as claimed by the appellant
> is clearly anticipated by the structure and the processes
> as shown in the combination of *Pool/Kroenke*.

First, this is a completely unsupported assertion by the Examiner. Second, if what the Appellants have claimed is "clearly anticipated," then it should be quite easy for the Examiner to point out with specific citations within these references. Instead, the Examiner has failed to do so.

The Examiner has asserted:

> The Appellant asserts that the matching step is not taught. However, Database filtering and querying is nothing more than a complicated series of matching steps.

Appellants have not merely asserted a matching step in a vacuum, but have asserted that the matching step in the claim is not taught or suggested as asserted by the Examiner. Merely reciting that database filtering and querying is possible and taught within the references does not equate to the specific recitations within the claims.

Appellants have asserted in the Appeal Brief that the outputting step in claim 1 is not disclosed in *Pool*, since *Pool* will not produce the data record that includes the tariff classification information associated with the product identifier identifying the product. The Examiner asserting that "*Pool* clearly discloses an output when he discloses that computers and databases are used for the purchases and transactions of business services" does not equate to teaching the outputting step of the claims.

Claims 2-3 and 11-12 recite emailing or downloading the data record to a second terminal coupled to the network. This data record includes tariff classification information associated with the product identifier identifying the product. The Examiner has asserted that the "data set itself that is carried on the transfer is nonfunctional descriptive data and is given no weight." This standard promulgated by the Examiner is in error. The data record is defined within the claims as including tariff classification information associated with the product identifier identifying the product. For the Examiner to prove a *prima facie* case of anticipation or obviousness, the Examiner must address all of the claim limitations, and must therefore consider

that claims 2-3 and 11-12 recite email or downloading the data record that includes tariff classification information associated with the product identifier identifying the product. The Examiner cannot ignore claim limitations. The Examiner then goes on to assert that even if such language was given weight, it can be easily shown that *Pool* discloses this electronic flow of data as an inherent part of the process of the import/export transaction system. Again, the Examiner is referred to MPEP § 2112. The Examiner cannot make such an inherency argument without providing objective evidence showing how such claim limitations <u>necessarily</u> flow from the teachings of *Pool*. The Examiner's statement that such an electronic flow of data is an inherent part of the process of the transaction system pool is unsupported.

With respect to claims 5, 14 and 21, column 3, lines 60-62, and the Abstract of *Pool* do not teach or suggest the downloading of the data record in response to access of the data record and the server by a second terminal using a web browser, wherein the data record includes tariff classification information associated with the product identifier identifying the product.

With respect to claims 8 and 26, the Examiner has asserted that "it is more than obvious that the database to be updated [sic] quickly and easily." The Examiner is just merely asserting that such claims are obvious, but has not supported such an assertion with objective evidence.

The same is true with respect to claims 9 and 18. Again, the Examiner is <u>merely</u> relying upon his <u>subjective</u> assertion that such claim limitations are obvious.

With respect to claims 10 and 19, the Examiner's only response to Appellants' assertions that the Examiner has not addressed all of the claim limitations, plus numerous other arguments by Appellants, is merely that the "Examiner has taken the broadest and most reasonable interpretations of the claim language in light of the specification and has made a rejection that is both reasonable and supported by the evidence of *Pool* and *Kroenke*." Such an assertion by the Examiner does not support a *prima facie* case of obviousness. Appellants have made their traversals, and it is the Examiner's responsibility to specifically address such traversals. MPEP § 707.07(f).

Appellants respond similarly with respect to claims 17 and 19. The Examiner has again just merely asserted that he has taken the broadest and most reasonable interpretations of the claim language, etc.

The Examiner has then gone on to assert that "[t]he Appellant's variations of the Web-enabled client/server database system amount to nothing more but equivalent design choices that do not enhance or otherwise improve the system as disclosed by a combination of *Pool/Kroenke*." Such statements by the Examiner are not sufficient to prove a *prima facie* case of obviousness. The Examiner must specifically address the claim limitations and not make broad allegations.

With respect to claim 22, the Examiner has asserted that "*Pool* discloses retrieving information from the database and placing it into a form that is largely equivalent to what the Appellant has claimed with minor differences that would have been considered obvious to one of ordinary skill in the art." This is an unsupported assertion by the Examiner. What are the minor differences? How are such minor differences obvious to one of ordinary skill in the art? How is what *Pool* discloses "largely equivalent" to what Appellants have claimed? Too many question marks -- resulting in an insufficient *prima facie* case of obviousness.

With respect to claims 24 and 25, on page 27 of the Supplemental Examiner's Answer, the Examiner has asserted that "the Appellant asserts that the recording step is not shown," and "storing data on a database is more than obvious to one of ordinary skill in the database arts." Appellants do not understand the Examiner's assertions with respect to the recording step. Where is a recording step recited in claims 24 and 25?

With respect to claims 27 and 28, the Examiner has asserted that "it is obvious to one of ordinary skill in the art to produce a product identifiers [sic] and transaction identifiers specific to particular products and transaction [sic] and the company is provides [sic] its structure and mechanism for database applications to quickly sort store [sic] and retrieve orders and transactions based any [sic] one of the aforementioned identifying numbers." This assertion by the Examiner is completely

unsupported and amounts to the Examiner just saying the claims are obvious without any objective evidence to support his assertions.

Further, a VIN number or a receipt from an auto dealership does not address the specific claim recitations of product identifiers and tariff classification information particular to each of the product identifiers.

The Examiner then goes on to make the following statement:

> Appellant's challenge of the Examiner's use of Official Notice is unsound because nowhere in the prosecution history has the Appellant asserted that the Examiner has made an error in taking Official Notice. Therefore, evidence to support the Official Notice is not required.

The Examiner is in error. The Examiner first made such an Official Notice assertion in the Office Action dated December 3, 2003. Appellants' response to that Official Notice assertion was the Appeal Brief where Appellants did traverse the Official Notice.

With respect to Appellants' assertions in the Appeal Brief regarding claim 30, all the Examiner has done is to assert "since *Pool* discloses that the database can assign commodity codes, it would have been obvious to one of ordinary skill in the art to modify this assignment of commodity codes to include product identifiers and tariff classification information." First of all, such an assertion by the Examiner does not address Appellants' traversals in the Appeal Brief. Secondly, again the Examiner is merely making a blanket "obvious" assertion without any factual backup.

Claim 31 is a method whereby the database is modified to update the product identifiers and/or tariff classification information particular to each of the product identifiers to ensure an accuracy of associations between the product identifiers and corresponding tariff classification information. Therefore, the limitation of "to ensure an accuracy of associations between the product identifiers and corresponding tariff classification information" does not disclose merely an intended use of the product, but is part of a method step, and must be given weight by the Examiner.

With respect to claims 32 and 44, Appellants have not misinterpreted the Examiner's intentions and rejections. Logic dictates what the Examiner is asserting. The Examiner's rejection when taken to its logical conclusion does not make sense.

With respect to claim 34, the order disclosed in *Pool* is not the same as a customer entry report. In response to this assertion by Appellants in the Appeal Brief, the Examiner has merely asserted that "the order disclosed by *Pool* is equivalent to the customer entry report and is therefore an obvious modification to one of ordinary skill in the art." First, this does not address Appellants' traversal as required under MPEP § 707.07(f). Secondly, the Examiner's assertions are unsupported. The Examiner needs to prove with objective evidence how the order disclosed by *Pool* is equivalent to the customer entry report and/or is an obvious modification.

With respect to claims 38, 50 and 55, the Examiner has merely asserted that this "type of unique identification is merely a variation of the same procedures that are used when consumers purchase goods and services from vendors or retailers." Again, Appellants respectfully assert that the Examiner's rejection is without objective support.

With respect to claim 39, again, the Examiner has not specifically addressed Appellants' traversals that the commodity code disclosed in *Pool* is not unique to a particular company.

With respect to claims 43, 52 and 55, the Examiner asserts that since *Pool* discloses import and export transactions, it inherently discloses legal compliance, various identifiers, and updating databases. Appellants traverse. *See* the requirements under MPEP § 2112.

With respect to claim 53, Appellants traverse the assertion that is inherent to facilitate passage of the products through the country's customs office using the master report created as a result of the comparing step trade. *See* MPEP § 2112.

With respect to the Examiner's recitation of *In re McLaughlin*, this case still requires that there be some objective evidence for supporting a combination of two references. All the suggestions to combine the references provided by the Examiner in his Examiner's Answer and previous Office Actions are <u>unsupported subjective</u>

opinions. The Examiner has provided <u>no</u> <u>objective</u> <u>evidence</u> how either of the prior art references suggest their combination, or that of general knowledge known to those skilled in the art. Therefore, the only objective evidence that can be pointed to for arriving at the claimed invention is the Application itself. This is hindsight.

With respect to claim 35, the Examiner has asserted the following:

> With regard had [sic] to the Appellant's assertions concerning claim 35, it appears as if the Appellant is trying to persuade the Examiner and the board that placing data items in order for the purposes of sorting could in no way be a normal function of structure, logic, and reasoning, and therefore must be the result of hindsight reasoning provided singularly by the Appellant. This of course is preposterous as the Examiner's rejections show.

Appellants respectfully assert that it may seem preposterous now that the Examiner knows the answer. However, <u>at the time the invention was made,</u> one skilled in the art would <u>not</u> have been able to arrive at the claimed invention in view of the three references. The Examiner's assertions with respect to claim 35 are not the legal standard for showing obviousness.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellants

By:_____

Kelly K. Kordzik
Reg. No. 36,571

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2851